(24)

Supreme Court of the United States

OCTOBER TERM, 1944

No. 599-600

OTTO LIND and THE PROCTER & GAMBLE COMPANY,

Petitioners,

v.

CONWAY P. COE, Commissioner of Patents,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA AND BRIEF IN SUPPORT THEREOF

NELSON LITTELL,
ALBERT C. JOHNSTON,
ROBERT C. WATSON,
Counsel for Petitioners.

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TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners, appellants below, pray the issuance of a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia entered in the above entitled causes on June 19, 1944 (petition for rehearing denied July 18, 1944), affirming the judgment of the District Court of the United States for the District of Columbia for respondent, appellee below. A transcript of the record in the case, including the proceedings in the said Court of Appeals, has been furnished in accordance with Rule 38 of the Rules of this Court.

Summary and Short Statement of Matter Involved

Your petitioners brought two actions against the Commissioner of Patents in the District Court of the United

States for the District of Columbia under the provisions of R.S. Sec. 4915, to secure the grant of patents on two applications for patent which had been refused by the Commissioner of Patents.

In the action involving application Serial No. 234,952, claims 1 to 3 had been found to be patentable by the Patent Office and a patent had been issued thereon to another and junior applicant, Fiske (Patent No. 2,092,913, R. 81-84). These claims were rejected to your petitioners solely on the ground of estoppel. Other claims in application Serial No. 234,952 and application Serial No. 752,462 were rejected to your petitioners by the Commissioner of Patents as unpatenable over the prior art.

In the District Court your petitioners were found *not to be estopped* as to claims 2 and 3, but, instead of directing the issuance of a patent thereon, upon overruling the Patent Office decision, the District Court undertook to determine anew the patentability of claims 2 and 3 and proceeded to reverse the original determination by the Patent Office that these claims were patentable. The District Court specifically found, however, that there was no disclosure of the subject matter thereof in the prior art (Finding No. 17, R. 10). It also held the remaining claims unpatentable over the prior art, although it found that the subject matter thereof was not disclosed in the prior art (R. 10).

On appeal, the Circuit Court of Appeals of the District of Columbia affirmed the District Court in a per curiam memorandum, without opinion (R. 191). Neither the District Court nor the Circuit Court of Appeals discussed the evidence of invention presented by your petitioners, nor did they find that the original determination of patentability as to claims 1 to 3 made in the Patent Office was unfounded in fact or based on insufficient evidence.

Jurisdiction

Jurisdiction of this Court is invoked under Section 239 of the Judicial Code, as amended by the Act of February 13, 1925, 28 U. S. C. A., Section 347.

Federal Statutes Involved

Revised Statutes:

Sec. 476 (U. S. C., title 35, sec. 2.) There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners in chief, who shall be appointed by the President; by and with the advice and consent of the Senate.

Sec. 482 (U. S. C., title 35, sec. 7.) The examiners in chief shall be persons of competent legal knowledge, and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioners, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases.

Sec. 4886 (U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been

abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, * * *.)

Sec. 4904 (U. S. C., title 35, sec. 52.) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.

Sec. 4915 (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law.

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Questions Presented

The issues raised in this petition are twofold:

(1) Whether, after the United States Patent Office has determined that certain claims involve invention and are patentable but has refused these claims to your petitioners on a point of law (estoppel) and the District Court and the Court of Appeals of the District of Columbia find that your petitioners are not estopped, it is within the province of these Courts to reopen the question of patentability and reverse the original decision of the Patent Office on this point.

(2) Whether the patentability of your petitioners' remaining claims shall be measured by R. S. Sec. 4886 and the evidence of invention presented or shall depend upon the personal views of the justices of the Court of Appeals for the District of Columbia, as to the type of mental process of the inventor necessary to produce inventive genius.

Reasons for Granting the Writ

Writ of certiorari should be granted under Paragraph 5 of Rule 38 of this Court for the following reasons:

(1) The District Court and the Court of Appeals for the District of Columbia have not followed customary rules of administrative law to the effect that administrative determinations of fact shall not be disturbed if supported by substantial evidence. In the administrative tribunal, namely, the United States Patent Office, it was determined that certain claims (1 to 3) were patentable as a matter of fact, but that petitioners were estopped as a matter of law to receive these patentable claims. In the District Court it was decided that the alleged estoppel did not apply to some of these claims (namely, 2 and

3) but that the decision of the Patent Office that these claims were patentable as a matter of fact should be *reversed*. There was no finding that the determination of fact as to the patentability of claims 1 to 3 by the administrative tribunal in your petitioners' favor was not supported by the evidence. The Court of Appeals affirmed the District Court without opinion.

(2) The affirmance by the Court of Appeals for the District of Columbia was based solely on citations of recent cases wherein that Court has substituted for the statutory measure of patentability an unsanctioned measure based upon personal views of its members which is contrary to that applied in decisions of this Court and of the United States Court of Customs and Patent Appeals.

(3) It is a matter of great importance to the orderly administration of the functions of the Patent Office to decide whether the United States Patent Office or the Federal Courts shall in the first instance determine the fact of invention and whether when the Patent Office has determined that an invention is defined in particular claims this question can be reopened and the Patent Office reversed on an administrative appeal where it is not necessary for the Court to reopen the question of patentability in order to decide the issues brought before it by the appeal.

(4) The question of the general standard of invention to be applied in the administration of the Patent Laws is a matter of great importance to the public and, some declaration by this Court is needed as to whether this standard shall be based upon evidence of the promotion of the progress of science and of qualification for a patent under R. S. 4886, or whether the standard shall depend upon some arbitrary concept of invention divorced from evidence and the statutory provisions.

Prayer

WHEREFORE your petitioners respectfully pray that writ of certiorari be issued directed to the Circuit Court of Appeals for the District of Columbia commanding that Court to certify and to send to this Court for its review and determination a full and complete transcript of the record and all proceedings in the cases numbered Nos. 8519 and 8520, entitled on its docket Otto Lind and The Procter & Gamble Company, Appellants, v. Conway P. Coe, Commissioner of Patents, Appellee, and that the said decree of the Court of Appeals of the District of Columbia may be reversed by this Honorable Court, and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

Respectfully submitted,

OTTO LIND and THE PROCTER & GAMBLE COMPANY,
Petitioners.

by

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ALBERT C. JOHNSTON,
ROBERT C. WATSON,
Counsel.